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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,940

04/06/2007

Rolf Weiler

AP 10800

7081

52203 7590 07/20/2011

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EXAMINER

BURCH, MELODY M

ART UNIT

PAPER NUMBER

3657

MAIL DATE

DELIVERY MODE

07/20/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,940	<b>Applicant(s)</b> WEILER ET AL.
	<b>Examiner</b> MELODY BURCH	<b>Art Unit</b> 3657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 7-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br/>Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
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## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 12/10/10 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the incorporation by reference statement added in the amendment to the specification filed on 12/10/10.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 7-10 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4394891 to Oshima.

Re: claims 7, 8, 9, and 12-14. Oshima shows in figures 1 and 2 a spot type disc brake comprising a brake caliper 7 straddling a brake disc 1; a brake lining 3 displaceably arranged in relation to the brake caliper for tribological interaction with the brake disc when the brake is applied; at least one actuating device arranged in the brake caliper, the actuating device 8 including a piston 13 that exerts an application force on the brake lining 3; and a spring assembly 9 to adjust a clearance between the brake lining and the brake disc after brake application, which is detachably fastened in

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the spot type disc brake, wherein the brake lining 3 and the actuating device 8 are both located on a same side of the brake disc 1 as shown and wherein the spring assembly includes a spring element 9g, 9h which is at least radially and axially supported on the brake caliper 7 and, in addition, comprises a spring clip 9c, 9d connected to the spring element and being detachably fastened at the brake lining by way of two spring arms 9a, 9b.

Re: claim 10. See elements 3b and 3c in figure 4.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oshima in view of US Patent 2711801 to Super et al.

Oshima is silent with regards to the spring clip and the spring element being designed as separate components.

Super et al. teach in col. 1 lines 29-31 the use of spring device used for supporting a brake component either being an integral spring element and clip combination or being formed of separate spring element and clip pieces.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the spring clip and spring element of Oshima to

have been made of separate components, in view of the teachings of Super et al., in order to provide a functionally equivalent means of supporting the brake pad/lining depending on assembly and cost requirements.

### ***Response to Arguments***

6. Applicant's arguments filed 5/2/11 have been fully considered but they are not persuasive.

Applicant first argues that since the 12/10/10 amendment is simply an explicit statement of the incorporation by reference that resulted from the priority claim on the day the application was filed, the amendment does not constitute new matter in light of the discussion in MPEP 201.13. While Examiner acknowledges that section (G) of MPEP 201.13 states that for US applications filed on or after September 21, 2004, a claim for foreign priority present on the filing date of the US application is considered an incorporation by reference of the foreign application and that the section encourages Applicants to provide an explicit incorporation by reference statement, Examiner notes that the incorporation by reference discussed in this section is limited to ***inadvertently omitted material***. Examiner maintains that the newly added incorporation by reference in the 12/10/10 amendment is new matter with respect to material which was NOT inadvertently omitted. In fact, the cited section states that Applicants are encouraged to provide an explicit incorporation by reference statement to the prior-filed foreign priority application(s) for which priority is claimed under 37 CFR 1.55 "if applicants ***do not wish the incorporation by reference to be limited to inadvertently omitted material*** pursuant to 37 CFR 1.57(a)."

With regards to the art rejections, Applicant argues that Oshima teaches a spring that is supported by both brake linings instead of by one of the brake linings (particularly, the one brake lining that interacts directly with the actuating device). Examiner notes that Applicant's arguments are more specific than the claim language. While Examiner acknowledges that the spring 9 is supported by both brake linings (including the brake lining that interacts directly with the actuating device), Examiner notes that there is nothing in the claim language to preclude the other brake lining (the one that does not interact directly with the actuating device) from also supporting the spring. Examiner recognizes Applicant's emphasis of the word "the" in the "the brake lining" phrases on pg. 7 of the Remarks. Examiner maintains, however, that the use of the word "the" in the phrase "the brake lining" does not serve to preclude the presence of a second brake lining also acting as a spring support especially since the claims include the open-ended transition term "comprising".

Accordingly, the above rejections have been maintained.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb  
July 17, 2011

/Melody M. Burch/  
Primary Examiner, Art Unit 3657

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